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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,164	03/10/2004	David T.E. Ely	1179-55	3037
23117	7590	06/14/2005	EXAMINER	
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			WONG, ALBERT KANG	
			ART UNIT	PAPER NUMBER
			2635	

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/796,164

Applicant(s)

ELY ET AL.

Examiner

Albert K. Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 74-90 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 74-86 and 88-90 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 87 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/111,885.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

1. This Office action is in response to the application filed March 10, 2004. This application claim priority to application 09/111,885, filed July 8, 1998 (now Patent 6,249,234). Although this application asserts priority to applications filed prior to July 8, 1998, it appears that the subject matter presently claimed was first disclosed in that application. If applicant disagrees with this assessment, he is requested to provide evidence to support his claim for earlier priority. Claims 74-90 are pending. The preliminary amendment filed March 10, 2004 has been entered. The IDS filed March 10, 2004 is acknowledged.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 82, 84-85 and 88 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 82 and 88, it is not clear what constitutes the first and second amplitude measures since they lack an antecedent basis.

Regarding claim 84, said signal generator lacks an antecedent basis.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 74-81, 83-86, and 89-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto 5,691,513. Although specific passages in the patent has been cited

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to show the claimed limitations, it should not be construed to be the only teaching within the patent. It is suggested that applicant consider the entire reference.

Regarding claim 74, Figure 7 teaches the claimed planar array of x-y coils and electromagnetic field generator. The processing circuitry is shown generally in figure 1 and described in cols. 9-10. Yamamoto teaches that the surface is initially scanned to determine if a stylus is within the range of heights above the surface for proper input. Although this is described in terms of a passive stylus, it would have been obvious that the same scanning circuit would be used for an active stylus to accomplish the same desired function.

Regarding claims 75, Figure 7 shows a plurality of x and y sensor coils. Also see corresponding written description.

Regarding claims 76-77, after the rough scanning of the planar array of coils, the circuit scans a particular location to determine the x and y coordinates of the electromagnetic field generator to determine position. This is accomplished via the processing circuitry that measures electric field strength.

Regarding claim 78, see figures 2-4.

Regarding claim 79, it is conventional to use loops in series with opposing fields to cancel stray fields. Also, see Russell reference. It would have been obvious to use conventional panels in a digitizer system to accomplish the same functions.

Regarding claim 80, the stylus generates an electromagnetic signal that is received by the coils to determine distance and location.

Regarding claim 81, Yamamoto does not explicitly teach how the height is determined. Yamamoto teaches the scanning of the coils in the x and y direction. It would have been obvious

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that the amplitude of the signal strength would be dependent on the height of the stylus from the coils.

Regarding claim 83, see item 50 in figure 7.

Regarding claims 84 and 85, see figure 1.

Regarding claim 86, this claims is essentially the same as claim 81 and is rejected for the same reasons.

Regarding claims 89 and 90, these limitations have been addressed above.

6. Claim 87 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited art provides a more detailed description of the touch pad systems.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Albert K. Wong whose telephone number is 571-272-3057. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703-305-4704. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**ALBERT K. WONG**  
**PRIMARY EXAMINER**

Albert K. Wong  
June 6, 2005